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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,185	12/15/2003	Nobuo Sugino	F-8064	4336

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EXAMINER


LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,185	Applicant(s) SUGINO, NOBUO 	
	Examiner Jerry A. Lorengo	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

(1)

Specification

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

(2)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.¹

(3)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,601,959 to Brault et al.

Regarding applicant claims 1, 7 and 10, Brault et al. disclose a transfer method comprising the steps of (Figures 1-12; column 4, line 38 to column 9, line 63):

¹ Note to Applicant: Although the instant claims are replete with grammatical and syntactic errors, the Examiner has established the grounds of rejection in sections (3) and (4) based upon the broadest reasonable interpretation of the claims as currently written.

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(1) Providing a transfer sheet comprising a carrier 24 and transferable overcoating layer 26 (column 4, lines 20-35);

(2) Providing a pattern 18 onto the upper surface of the transfer sheet by electrophotographic printing (column 4, lines 38-62);

(3) Applying an adhesive 22 onto the image 18 disposed on the surface of the transfer sheet 24,26 (column 5, line 41 to column 6, line 17);

(4) Contacting under the effects of pressure and/or heat, the adhesive coated transfer sheet 24,26,18,22 with a target substrate 20 to bond and transfer the image 18 with the substrate 20 via the adhesive layer 22 (column 6, lines 27-63); and

(5) Stripping or peeling the carrier 24 of the transfer sheet 24,26 from the image 18 adhesively bonded to the substrate 20 (column 6, lines 64-68).

Regarding applicant claims 1, 2, 7 and 10, Brault et al. disclose that the adhesive may comprise a pressure-sensitive, such as 3M Scotch Brand Spray Mount (a transparent adhesive), or heat activatable adhesives such as those based on thermoplastic polyurethane, polycaprolactone and acrylic copolymers (column 5, lines 41 to column 6, line 26).

Regarding applicant claims 4-6 and 8-12, Brault et al. disclose that the transfer sheet 24,26 may utilize a release layer ("remover layer") 30 disposed over the carrier sheet by coating (column 8, lines 55-59).

(4)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,601,959 to Brault et al. in view of U.S. Patent No. 6,110,317 to Sandor.

Brault et al. disclose a transfer method wherein the transfer sheet includes an intermediate layer 26 between the release layer 30 and the image layer 18 which, upon transfer, remains attached in an overlaying relationship to the image layer 18 adhered to the substrate 20 by adhesive layer 22. Brault et al. Further disclose that the intermediate layer 26 is transparent and protects the image 18 from abrasion, fading, chemical degradation or damage (column 9, lines 13-20).

Although they do not specifically disclose, as per applicant claim 3, that such a protective layer is applied over the transferred image after the transfer step has been carried out, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the protective layer of Brault et al. either simultaneously with transfer or as a subsequent step following transfer motivated by the fact that Sandor, also drawn to method for the adhesive transfer of electrophotographic images from a transfer sheet to a target substrate (abstract), disclose that following transfer, the image can be overcoated with a layer of clear, durable seal coat resin, i.e., a varnish (column 7, lines 19-22; column 10, lines 40-50).

(5)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such prior art includes references C-M listed on Form PTO-892.

(6)

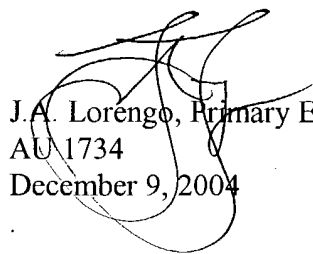
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J.A. Lorengo, Primary Examiner
AU 1734
December 9, 2004